

REMARKS/ARGUMENTS

Applicant has reviewed the detailed Office Action mailed November 10, 2009 (paper no. 20091027). In the outstanding Office Action, 1) claim 99 was withdrawn from consideration as being directed to a non-elected species, and 2) claims 77 and 85 were rejected under 35 U.S.C. § 102(b). In this paper, claims 77 and 85 have been amended, and new claims 100 and 101 have been added. Thus, upon entry of this response, claims 77, 85, 100 and 101 will be pending in this application. Applicant requests reconsideration of the pending claims in view of the following remarks.

Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers.

Claim Rejections Under 35 U.S.C. §102

In the outstanding Office Action, claims 77 and 85 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,699,900 to Artis (hereinafter referred to as “Artis”). For the following reasons, Applicant respectfully traverses this rejection.

Claims 77 and 85 are Patentable Over Artis

The outstanding Office Action rejected claims 77 and 85 as being anticipated by Artis. Applicant respectfully disagrees.

Regarding claim 77 as amended, recites:

A reusable holder for a fully enclosed contact lens cases comprising:
a base;
one or more receptacles formed in said base configured to receive a fully enclosed contact lens case; and
a time keeping device; wherein the time keeping device comprises a case life indicator for each one or more receptacles that indicates a period of time to discard the fully enclosed contact lens case currently in the receptacle;
wherein said one or more receptacles configured to receive a contact lens case includes:

a contact lens case engagement surface formed on said one or more receptacles configured to receive said contact lens case in said one or more receptacles; and

an actuator formed on said base, wherein said actuator is configured to be triggered and reset said time keeping device when a contact lens case is received in said one or more receptacles;

further comprising at least one fully enclosed contact lens case, wherein the fully enclosed contact lens case comprises a bottom member having a fluid retaining well with a generally concave shape;

wherein the contact lens case has a top and a bottom defining a fluid tight lens reception cavity; and

wherein the bottom of the contact lens case is placed in the receptacle.
(Emphasis added).

As illustrated above, claim 77 recites a holder configured to retain at least one fully enclosed contact lens case while simultaneously providing a timer that indicates to a user when the useful life of a fluid retaining contact lens and its associated lens case has expired. As noted in the specification, there has been little attention given to the need to replace contact lens storage cases. See Specification, [0157].

In contrast, Artis utterly fails to teach, suggest, or otherwise disclose a number of the recited claim elements. Rather, Artis teaches a contact lens case that operates to display the number of days that a contact lens has been worn by the contact lens wearer. Artis does not teach 1) a receptacle for receiving an enclosed contact lens case, 2) case life indicator for each one or more receptacles that indicates a period of time to discard the fully enclosed contact lens case currently in the receptacle, or 3) a contact lens case having a top and a bottom defining a fluid tight lens reception cavity.

First, in contrast to the claimed elements, Artis fails to teach a receptacle for receiving an enclosed contact lens case. The outstanding Office Action argues that element 34 is considered a contact lens case. *See Office Action, p. 3.* However, element 34 of Artis is in no way, and cannot reasonably be considered to be an enclosed contact lens case. Rather, as taught in Artis, the holder 34 does not encase the lenses, rather, element 34 of Artis is merely a lens retaining member. Artis, col. 3 lines 1-2. The lens retaining member 34 is made of baskets 36 and 34 configured to retain, but not encase the contact lenses. *Id.*, col. 3 lines 1-12. To the contrary, retaining member 34 of Artis is configured to provide one or more lenses access to a disinfecting

solution after each use. *Id.*, col. 3 lines 36-45. Artis clearly teaches a single contact lens case, as evidenced by the title of Artis and throughout the reference, such as the case meant to be received and timed by the holder of claim 77. *See Artis, Title.* Contrary to the assertion in the outstanding Office Action, individual components of the case taught in Artis cannot be separately considered as an enclosed case, as recited in independent claim 77.

Additionally, Artis utterly fails to teach a case life indicator for each one or more receptacles that indicates a period of time to discard the fully enclosed contact lens case currently in the receptacle. As noted above, claim 77 recites providing a timer that indicates to a user when the useful life of a lens case has expired. In contrast, Artis teaches a contact lens case including a “counter 40” for counting insertions of the contact lens case cover into the housing. *See Artis, col. 3 lines 13-16.* No timer indicator configured to denote the use full life of the secondary contact lens case is taught or suggested in Artis. Rather, Artis teaches a mechanical use counter that indicates the number of times the lens retaining member of the contact lens case, and consequently the associated lens, is inserted into the housing. *Id.* This indicator is not a reliable timer as multiple uses or insertions of the lens retaining member into the housing in a single day will continue to advance the counter. Similarly, if a contact lens is stored in the contact lens case of Artis for multiple days (if perhaps a user also uses glasses for a prolonged period of time), the taught indicator will remain static and not advance. This teaches away from the claimed elements as such a situation will allow for contamination of the contact lens case of Artis, due to, for example, growth of an undesirable bacteria, without warning or other visual indication to the user.

To further develop this point, Artis teaches that the counter is indicative of the useful life of the contact lens itself. *See Artis, col. 3 lines 53-59.* And particularly identifies the useful life of a contact lens, without reference or attention to the potential useful life of a contact lens case. In direct contrast, independent claim 77 focuses on a timer that is solely configured to track a period of time to discard a fully enclosed contact lens case currently in the receptacle, based on the use full life of a contact lens case.

Lastly, Artis fails to teach a contact lens case having a top and a bottom defining a fluid tight lens reception cavity. As noted above, the outstanding Office Action points to the holder 34

[as being] considered a contact lens case. *See* Office Action, p. 3. However, contrary to the amended claim 77, the element identified in Artis as the “contact lens case” fails to have a fluid retaining well with a top and a bottom that define a fluid tight lens reception cavity, as recited. Rather, the holder 34 of Artis includes fluid permeable baskets to retain the contact lens. Artis, col. 3 lines 1-12. In order for the contact lens case of Artis to perform its intended purpose, the baskets that make up the holder must be fluid permeable to allow access of the disinfecting solution to the lenses. *See* Artis, col. 3 lines 36-38. This is contrary to the elements recited in claim 77.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, because Artis fails to set forth each and every element of independent claim 77, as explained above, the rejection of independent claim 70 under 35 U.S.C. § 102 based on Artis should be reconsidered and withdrawn.

Similarly, Artis utterly fails to teach, suggest, or otherwise disclose the elements claimed in dependent claim 85. Similar to independent claim 77, independent claim 85 recites a reusable holder for contact lens case including 1) a receptacle for receiving an enclosed contact lens case and a 2) case life indicator for each one or more receptacles that indicates a period of time to discard the fully enclosed contact lens case currently in the receptacle. Consequently, the arguments made above are equally applicable to independent claim 85.

Again, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, because Artis fails to set forth each and every element of independent claim 85, as explained above, the rejection of independent claim 85, and all claims that depend there from, under 35 U.S.C. § 102 based on Artis should be reconsidered and withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant has authorized payment for a three month extension of time with this response. Applicant believes no other fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2623 under Order No. 41364.0043 from which the undersigned is authorized to draw.

Respectfully submitted,

DATE: May 10, 2010

BY: /Bryan G. Pratt/
Bryan G. Pratt, Esq.
Registration No. 48,873
Holland & Hart LLP
60 East South Temple, Suite 2000
Salt Lake City, UT 84111
Phone: 801-799-5802
Fax: 801-823-2206